



2675
AF
2675

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Leroy B. KEELY et al.)
Serial No.: 09/750,288) Group Art Unit: 2675
Filed: December 29, 2000) Examiner: A. Awad
For: CLASSIFYING, ANCHORING, AND) Attorney Docket No. 003797.00071
TRANSFORMING INK)

MAIL STOP APPEAL BRIEF-PATENTS

U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

REPLY APPEAL BRIEF

Sir:

This Reply Brief is submitted in accordance with 37 C.F.R. § 1.193 (b), filed in triplicate, in reply to the Examiner's Answer. Please charge any necessary fees in connection with this Reply Brief to our Deposit Account No. 19-0733. Appellant's arguments begin on the following page.

ARGUMENT

The Examiner's Answer only specifically addresses some of Applicants' many arguments for patentability to which Applicants responds. Applicants' response is need to address the positions taken by the Examiner in the Examiner's Answer.

Claims 1 and 14

With regard to the independent claims 1 and 14, the Examiner has used an alleged broadest reasonable interpretation to improperly parse the inventions. (Answer, pg. 9; "Response to Argument"). The Examiner has improperly distilled the inventions down to a "gist" or "thrust." *See W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1548, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert denied*, 469 U.S. 851. The Examiner re-characterizes Applicants' inventions to fit his own interpretation of the references for his distilling to an improper "gist" or "thrust." (See Answer, pages 9 and 10). This leads the Examiner to fail to consider the recited inventions as a whole in that the Examiner attempts to piece together selective teachings of Morishita and Maxted. Also, the Examiner is applying a *per se rule* of obviousness. Per se obvious rules are legally improper. *See In re Ochiai*, 71 F. 3d 1565, 1572, 37 U.S.P.Q. 2d 1127, 1133 (Fed. Cir. 1995). The Examiner states that because Morishita is a pen-based computer it must require editing. (Answer, pg. 11, lines 20-21). The alleged motivation relied upon by the Examiner in Maxted is the following:

"Theoretically, the greater the number of symbols in a given context the greater the chance that any individual symbol will be mis-interpreted. Further, the greater the number of symbols in a given context that are similar in orientation and/or shape, the greater probability that similarity orientated and/or shape symbols will be mis-

interpreted for one another.” (col. 2, line 63-67 to col. 3, lines 1-2)

There is nothing about the foregoing quote in Maxted (e.g., the alleged motivation) that teaches one of ordinary skill “[b]y adapting the teaching of Maxted of editing the text displayed by Morishita, the user can use fewer strokes from the electronic ink to edit the text and therefore both the time and power used” (Answer, pg. 11, lines 21-22 to pg. 12, line 1). In view of the foregoing reasoning of the final Office Action and the Answer, as clearly held by the U.S. Court of Appeals for the Federal Circuit, “[i]t is impermissible to use the claimed invention as an *instruction manual* or “*template*” to *piece together* the teaching of the prior art … [o]ne cannot use hindsight construction to pick and choose among isolated disclosures … to deprecate the claimed invention.” *In re Fritch* , 972 F.2d 1260, 1266 (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (emphasis added)). (See also M.P.E.P. 2142). In view of the foregoing, there is no *prima facie* case of obviousness and the rejections should be reversed.

Claims 3 and 16

With regard to dependent claims 3 and 16, the Examiner asserts that the recited classifying step is unclear with respect to the term “its distance.” (Answer, pg. 13) Applicants note that it is clear that the recited “its distance” is referring to “said electronic ink” in the respective base claim. This is because claims 3 and 16, further define the classifying step recited in the base claim. Further, claims 3 and 16 recite “other annotations”, which are missing from the references. In view of the foregoing, Applicants asserts that the Examiner has failed to establish a *prima facie* case of obviousness. Even if the Morishita had annotations, it is respectfully submitted that the Examiner has failed to demonstrate the references teach the recitations as claimed. The legal standard of

obviousness requires that “particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the matter claimed.” *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000) (emphasis added). In view of the foregoing, no *prima facie* case of obviousness has been established and the rejections should be reversed.

Claim 4 and 17

With regard to the dependent claims 4 and 17, the Examiner asserts that that the recitation of “determining the ratio of said electronic ink height to width” is the same as determining a line width. (Answer, pg. 14). The recited features are simply missing from the references. Notably, Morishita fails to teach the recited ratio of “said electronic ink to height”. There is no height determination of the electronic ink in Morishita. Hence, there can not be a teaching of the recited ratio as alleged by the Examiner. The Examiner has failed to establish a *prima facie* case of obviousness and the rejections should be reversed.

Claim 5 and 18

With regard to dependent claim 5 and 18, the recited anchoring step further defines the associating step of the classified ink in the respective base claim, e.g., claim 1 or 14. The Examiner asserts that Morishita’s teaching of circling a search region is the same as the recited anchoring step (Answer, pg. 14). Morishita fails to teach the recited no anchoring step or linking feature. The Examiner now states his interpretation of ‘anchoring’ with an alleged definition (Answer, pg. 14). Notably, there is no support for the alleged definition in the applied references. Further, the only motivation to combine the references comes from Appellant’s own specification, and the Federal

Circuit has repeatedly stated that the features of a claim in a pending application cannot be used as a blueprint to piece together prior art in hindsight, *In re Dembicza*k, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). The Patent Office should rigorously apply the requirement that a teaching or motivation to combine prior art references needs to be provided. *Id.* The combination is thus the result of improper hindsight reasoning, and the rejections should be reversed.

Claim 6 and 19

With regard to claim 6 and 19, the Examiner asserts that Morishita teaches the recited anchoring step. Applicants state that there is no step of “anchoring said electronic ink to a file position of said at least one object” in Morishita. Applicants’ incorporate by reference the arguments with respect to claims 5 and 18 against the Examiner’s interpretation of term “anchoring”. The rejections should be reversed.

Claims 9-13 and 22-26

With regard to dependent claims 9-13 and 22-26, the Examiner has used selected teachings of Maxted, Morishita, and Wilcox to make an improper combination. (Answer, pg. 16). Even if Wilcox had the additional recited elements in the noted claims, the Examiner is improperly applying a *per se* rule of obviousness (e.g., “classifying of the ink is necessary for manipulating and editing a document in handwritten forms as it is necessary in managing and editing a conventional word files to facilitate and ease the work of a user.”)(Answer, pg. 16) The only motivation to combine the three references comes from Applicants’ own specification. The law is clear that “[w]hen a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references.” *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998);

M.P.E.P. § 2143.01. Here, the Examiner has failed state a *prima facie* case of obviousness and the rejections should be reversed.

Claim 8

With respect to independent claim 8, the Examiner states “it is not clear to the examiner whether the re-flowing has occurred or not.” (Answer, pg. 15). The computer implemented method of claim 8 recites as part of the associating step, “wherein the relationship of said electronic ink to said at least one object is maintained despite re-flowing of said displayed information by a layout engine.” It is clear to one of ordinary skill in the art that term “despite” is used in that the noted relationship is maintained during or after “re-flowing of the displayed information.” The rejection under 35 U.S.C. § 112 should be reversed.

The Examiner now raises a new reason for the rejection under 35 U.S.C. § 102(e) based on alleged inherency. The Examiner believes it is inherent for a computer to have a layout engine with the recited functions of claim 8. (Answer, pg. 15) The Examiner, however, has failed to establish using Morishita that it is inherent that a recited layout engine performs the function of re-flowing the displayed information for maintaining the relationship of the electronic ink to the at least one object of the display information. It is well established that the fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Further, to establish inherency, extrinsic evidence must make clear that the missing descriptive matter is *necessarily present* in the article described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency may not be established by probabilities or possibilities. The mere

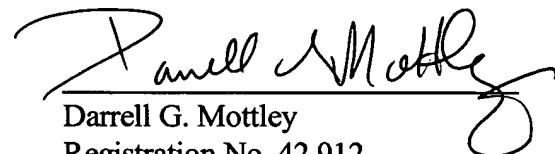
fact that a certain effect may result from a given set of circumstances is not sufficient. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). It is respectfully, submitted the rejection under §102 over Morishita should be reversed.

CONCLUSION

For all of the foregoing reasons in the Applicants' Appeal Brief and the instant Reply Brief, the final rejections of claims pending claims 2, 7, 8 and 27-29 under 35 U.S.C. § 102(e); claims 1, 3-6 and 14-21 under 35 U.S.C. § 103(a); and claims 9-13 and 22-26 under 35 U.S.C. § 103(a); claim 8 under 35 U.S.C. § 112, second paragraph; and claim 30 under 35 U.S.C. § 103(a) are improper. Reversal of the rejections and passage of the application to allowance are respectfully requested.

Respectfully submitted,

Date: February 14, 2005



Darrell G. Mottley
Registration No. 42,912

Banner & Witcoff, Ltd.
Eleventh Floor
1001 G Street, N.W.
Washington, D.C. 2001-4597
(202) 824-3000